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IN THE

Supreme Court of the United States

October Term, 1966
No. 1225

THE COLSON CORPORATION,

Petitioner,

vs.

EVEREST & JENNINGS INC., GERALD M. JENNINGS, HARRY C. JENNINGS, JR., and DAVID D. JENNINGS,

Respondents.

Brief of Respondents, Everest & Jennings, Inc., Gerald M. Jennings, Harry C. Jennings, Jr., and David D. Jennings, in Opposition to Petition for Writ of Certiorari.

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

The petition for a writ of certiorari should be denied in this case for the following reasons:

(1) There are no conflicting decisions by Circuit Courts of Appeal of different circuits on questions requiring reconciliation or resolution by this Court.

(2) The Circuit Court of Appeals for the Seventh Circuit affirmed the district court and expressly refused to find bad faith on the part of respondents.

(3) The record shows that the wheel chair patent in suit was held invalid by the Circuit Court of Appeals for the Seventh Circuit for failing to meet the nonobviousness requirement of 35 U.S.C.A. 103 and not for anticipation by respondents' prior wheel chair alone.

Concurrent Conclusions of the District Court and Circuit Court of Appeals Will Not Ordinarily Be Disturbed.

In *Universal Oil Products Co. v. Globe Oil Refining Co.*, 322 U.S. 471, this Court held:

> "Where the question presented by the contested claims of infringement and validity are purely factual, this Court ordinarily accepts the concurrent conclusions of the district court and Circuit Court of Appeals in these cases. Goodyear Co. v. Ray-O-Vac Co., 321 U.S. 275 (60 USPQ 386)."

In *Goodyear v. Ray-O-Vac, supra,* this Court stated:

> "The Circuit Court of Appeals re-examined the findings in the light of the evidence and accepted them. It must be a strong case in which this court will set aside these concurrent findings of two courts." (citing *Williams Co. v. United Shoe Machinery Corp.*, 316 U.S. 364, 367.)

Petitioner has attempted to show alleged conflict of decisions in different circuits on the question of allowance of attorney's fees upon findings of bad faith in connection with knowledge of prior art and prior public use of the patented devices.

In support of its position petitioner cites *Shingle Product Patents, Inc. v. Gleason,* 211 F. 2d 437 (9th

Cir.), and *Talon, Inc. v. Union Slide Fastener, Inc.*, 266 F. 2d 731 (9th Cir. 1959). Petitioner also cites *Walker Process Equipment Inc. v. Food Machinery and Chemical Corp.*, 382 U.S. 172 (1965), which reversed the Seventh Circuit Court of Appeals, and in which this Court held that patents procured by fraudulently concealing prior art are not entitled to anti-trust exemption. Petitioner also cited *Stock Equipment Co. v. Beaumont Birch Co.*, a Pennsylvania district court case apparently reported only 140 USPQ 134.

In the Ninth Circuit *Shingle Product* and *Talon* cases, the *Walker Process* case of this Court and the *Stock Equipment* case of the Pennsylvania district court, bad faith was found.

The fact that this Court overruled the Seventh Circuit Court of Appeals in the *Walker Process* case and rendered an opinion in agreement with *Shingle Product, Talon* and *Stock Equipment*, firmly establishes the law *where bad faith was found.*

In the present case, the district court did not find bad faith and refused to allow defendant-petitioner attorneys' fees.

Conclusion of Law 6 reads:

> "Defendant is entitled to judgment with costs. Defendant is not entitled to an allowance of attorneys' fees." (P. App. 269).*

The Circuit Court of Appeals for the Seventh Circuit discussed *Townsend Company v. M.S.L. Industries,*

*Plaintiffs-Respondents' Appellate Appendix.

7th Cir., 359 F. 2d 814 (1966) relied upon by petitioner before the Circuit Court. In distinguishing from *Townsend,* the Seventh Circuit Court of Appeals stated:

> "In Townsend, the trial court found the plaintiffs had brought their action in bad faith. The question on appeal was the propriety of the trial court's issuance of summary judgment, that is, whether there existed a genuine issue of material fact. Finding no such issue of fact, this court upheld the summary judgment of the trial court.
>
> "In the instant case, there was a trial, and the trial court, while finding and concluding the '449 patent invalid for anticipation and lack of patentable invention and not infringed by Colson's constructions, made no finding of bad faith in the application for the patent, and denied Colson an allowance of attorneys' fees.
>
> "Where the trial court has made no finding of bad faith, such a finding cannot readily be made on review from a cold record, we find none here. Cf. Talon, Inc. v. Union Slide Fastener, Inc., 9 Cir. 266 F. 2d 731, 739 (1959).
>
> "We hold that the district court did not abuse its discretion in failing to award attorneys' fees because of the alleged bad faith of Jennings." (Petition pp. 20-21).

In the cases cited by petitioner, bad faith was found and attorneys' fees were awarded. In the instant case, bad faith was expressly not found, and consequently, attorneys' fees were not awarded. This does not amount to a conflict of decisions. It is merely the application of the law to different sets of facts. The guide lines are clear and the decisions require no reconciliation by this Court.

The Fact That Neither the District Court nor the Circuit Court of Appeals Found the Patent to Be Anticipated by Respondents' Prior Construction Alone, but With That Construction in View of Prior Patents From a Different Art, Is of Itself Strongly Indicative That Respondents Were Not Guilty of Bad Faith.

The district court in Finding of Fact 6 stated:

> "The whole combination of elements purporting to be patented in the patent in suit, and every feature of alleged novelty of each element, *excepting only the pintle hinge (with pintles of equal or unequal length) of the patent compared with the bolt and nut hinge of prior use,* had been in public use and on sale and sold in commerical quantities, by plaintiffs and their predecessors for more than one year before the plaintiff filed the application for the patent in suit." (Emphasis supplied) (App. p. 262).
>
> "These charges comprised no more than the mere choice and selection of size and shape among old devices, with the result of but small increased or change efficiency and convenience." [Finding of Fact 8, P. App. p. 264].

The Circuit Court of Appeals for the Seventh Circuit, in concluding its opinion held:

> "In sum we hold that the patent in suit clearly fails to meet the nonobviousness requirement of 35 U.S.C.A. §103, and that there was no showing of bad faith requisite to justify an award of attorneys' fees." (Petition 21).

In Its Effort to Convince This Court That Respondents Acted in Bad Faith, Petitioner Has Erroneously Represented That "None of the Claims of This Patent, Albeit Invalid, Had Been Infringed by Colson." (P. App. p. 269.)

Upon defendant-petitioner's own motion, the district court ordered an amendment to Conclusion of Law 5. Original Conclusion of Law 4 (P. App. p. 269) reads:

> "None of the claims of Patent No. 2,592,449 has been infringed by defendant."

The order of the Court (P. App. p. 283) reads:

> "Conclusion of Law 5 delete the period and add the following:
>
> 'except as the accused form, Exhibit 20, was conceded to infringe if the patent were valid, and except as to the accused form of Exhibits 21, R and 65 wherein the pintles were of unequal length.' ".

Conclusion.

It is respectfully submitted that petitioner's contentions are without merit and that the petition should be denied.

Respectfully submitted,

ALLAN D. MOCKABEE,
ROY E. HOFER,
Attorneys for Respondents.

Certificate of Service.

It is hereby certified that copies of BRIEF OF RESPONDENTS, EVEREST & JENNINGS, INC., GERALD M. JENNINGS, HARRY C. JENNINGS, JR., AND DAVID D. JENNINGS, IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI were delivered this 1st day of May, 1967, to the office of Lowell E. Sachnoff, 105 West Adams Street, Chicago 3, Illinois.

ROY F. HOFER
Attorney for Respondents.